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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,744	04/20/2004	Tracy E. Grim	Royce-66794	5476

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FULWIDER PATTON LEE & UTECHT, LLP

Attention : Alan C. Rose  
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EXAMINER

PETRIK, KARI KRISTEN

ART UNIT

PAPER NUMBER

3743

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/828,744	<b>Applicant(s)</b> GRIM ET AL.	
	<b>Examiner</b> Kari Petrik	<b>Art Unit</b> 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.  
4a) Of the above claim(s) 1-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/20/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/31/2004</u> . | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims s 1-5 and 30-39, drawn to a method of applying splints or supports, classified in class 602, subclass 8.
  - II. Claims 6-29 and 40-47, drawn to a splint or support, classified in class 602, subclass 20.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used with a different process. The splint can be used by activating the hardening material and then applying it to the patient while it is still malleable, or the splint can also be used by applying the splint to the patient and then activating the hardening material.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1: Figure 3

Species 2: Figure 4

Species 3: Figure 5

Species 4: Figure 6

Species 5: Figure 7

Species 6: Figures 8 and 9

Species 7: Figure 10

Species 8: Figure 11

Species 9: Figure 12.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there are no generic claims.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. During a telephone conversation with Paul Fang on 1/26/2006 a provisional election was made with traverse to prosecute the invention of Group II, species 1, claims 40-47. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 40-42, 44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darcey (US Patent 6,106,492) in view of Parker et al. (US Patent 5,755,678).

Darcey discloses a splint comprising: an elongated blank (14) impregnated with hardenable material, at least one layer of additional non-impregnated material on at least one side of the blank (20), laterally extending primary tacking arrangements (26), and secondary holding arrangements for functionally securing the blank (Figure 11). The additional layer is a padding material (column 5, lines 59-65). One side of the blank is covered with a padding material (20) and the other with a hook receivable material (16, fabric is a hook receivable material) and the primary tacking arrangements are provided with a hook type construction thereon (32). The hook receivable material is UBL fabric (16), and the blank is formed of multiple layers of casting material (24). Darcey does not disclose a blank that is in roll form.

Parker et al. disclose a splint comprising: an elongate blank (10) in roll form (Figure 1) impregnated with a hardenable material, at least one layer of additional non-impregnated material (18), and secondary holding arrangements (Figure 10) for functionally securing the blank in place. The additional layer is a padding material (column 7, lines 37-42), and said blank is formed of multiple layers of casting material (16). Parker et al. specify that the splint be in roll form so that it can be dispensed in used-determined lengths suitable for any given medical use.

It would have been obvious to one skilled in the art at the time the invention was made to have provided the splint disclosed by Darcey wherein the blank is in roll form,

as taught by Parker et al., so that it can be dispensed in used-determined lengths suitable for any given medical use.

9. Claims 43, 45, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darcey (US Patent 6,106,492) in view of Parker et al. (US Patent 5,755,678) as applied to claim 40 above, and further in view of Grim et al. (US Patent 6,139,513).

Darcey in view of Parker et al. disclose the splint of claim 40 and explained in paragraph 8. Darcey does not disclose a splint wherein the padding material is a double knit fabric, the blank is formed of double knit spacer material, and the tacking arrangements are non-rectangular in shape.

Grim et al. disclose a splint comprising an elongated blank with hardenable material (202), at least one layer of additional non-impregnated material (30 and 32), and laterally extending primary tacking arrangements for holding said blank in place (204). Grim et al. further disclose a splint wherein a padding material is a double knit fabric (24 and 26), the blank is formed of double knit spacer material (28), and the tacking arrangements are non-rectangular in shape (204). Grim et al. specify that the use of double knit type material improve the control of the flow of water to the curable resin and provide desired strength for the product.

It would have been obvious to one skilled in the art at the time the invention was made to have provided the splint disclosed by Darcey in view of Parker et al. having padding material of double knit fabric, a blank of double knit spacer material, and

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tacking arrangements non-rectangular in shape, as taught by Grim et al., to improve the control of the flow of water to the curable resin and provide desired strength for the product.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kari Petrik whose telephone number is (571)272-8057. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (571)272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KKP  
VJP

Henry Bennett  
Supervisory Patent Examiner  
Group 3700